

REMARKS/ARGUMENTS

Claims 1, 2 and 4 through 6 are pending in the present application. Claims 1, 4 and 6 have been amended.

The Action (1) rejected claims 1 and 4 through 6 under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. JP62-299035 to Tsutsu (hereafter "the Tsutsu patent"); (2) rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. JP64-008667 to Arita et al. (hereafter "the Arita patent"); (3) rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. JP01-245226 to Tanaka et al. (hereafter "the Tanaka patent"); (4) rejected claims 4 through 6 under 35 U.S.C. 103(a) as being unpatentable over the Tanaka patent; (5) rejected claims 4 through 6 under 35 U.S.C. 103(a) as being unpatentable over the Arita patent; and (6) rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over the Tsutsu patent in further view of U.S. Patent 6,466,686 to Senior (hereafter "the Senior patent"), U.S. Patent 6,327,376 to Harkin (hereafter "the Harkin patent"), U.S. Patent 6,285,319 to Fujiwara (hereafter "the Fujiwara patent"), and U.S. Patent 5,559,504 to Itsumi et al. (hereafter "the Itsumi patent").

Regarding items (1) through (3) identified above, it is respectfully submitted that present claims 1 and 4 are each patentable over each of the cited references (i.e., the Tsutsu patent, the Arita patent, and the Tanaka patent) and that present claims 1 and 4 define inventions that are neither disclosed nor suggested by such cited references.

It is respectfully submitted that a rejection under 35 U.S.C. §102 requires that the prior art teach each and every

element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is further respectfully submitted that none of the three cited references disclose or suggest "at least one photosensitive element and at least one switching element with at least one layer of amorphous silicon on which an ITO (indium tin oxide) layer is provided" and "at least one SiN layer near [an] ITO layer, wherein said ITO layer is deposited prior to said SiN layer and an intermediate layer of silicon oxide is provided between said ITO layer and said SiN layer in such a manner that said at least one switching element is completely shielded during manufacture", as defined by claim 1. In addition, each reference likewise fails to disclose or suggest "a doped ITO layer on [an] at least one layer of amorphous silicon" (emphasis added), as defined by claim 4. Accordingly, reconsideration and withdrawal of the rejection, and allowance of claims 1 and 4, are respectfully requested.

With regard to claims 5 and 6, which depend either directly or indirectly from claim 4, it is respectfully submitted that such claims are patentable at least for the reason discussed above with respect to claim 4. Accordingly, reconsideration and withdrawal of the rejection, and allowance of claims 5 and 6, are respectfully requested.

Regarding items (4) and (5) identified above, it is respectfully submitted that a rejection under 35 U.S.C. §103 requires that all of the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03. Significantly, the prior art itself must suggest the modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). In addition, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. M.P.E.P. §2143.03.

Thus, it is respectfully submitted that at least because neither of the cited references (i.e., the Tanaka patent and the Arita patent) disclose or suggest the claim limitations defined by present claims 1 and 4, claim 1 and claims 4 through 6 are patentable thereover. Accordingly, reconsideration and withdrawal of the rejection, and allowance of claims 1 and 4 through 6, are respectfully requested.

Regarding item (6) identified above, it is respectfully submitted that present claim 2 is patentable over the cited reference combination (i.e., the Tsutsu patent, the Senior patent, the Harkin patent, the Fujiwara patent, and the Itsumi patent), and that claim 2, which depends directly from claim 1, defines an invention that is neither disclosed nor suggested by such reference combination.

In addition to failing to disclose or suggest, as noted in the Action, the use of a liquid crystal display as a fingerprint sensor, none of the cited references nor any combination of the same disclose or suggest "at least one photosensitive element and at least one switching element with at least one layer of

amorphous silicon on which an ITO (indium tin oxide) layer is provided" and "at least one SiN layer near [an] ITO layer, wherein said ITO layer is deposited prior to said SiN layer and an intermediate layer of silicon oxide is provided between said ITO layer and said SiN layer in such a manner that said at least one switching element is completely shielded during manufacture", as defined by claim 1. Thus, claim 2, which depends from claim 1, is likewise patentable. Accordingly, reconsideration and withdrawal of the rejection, and allowance of claim 2, are respectfully requested.

In sum, it is respectfully submitted that the present pending claims are clearly patentable over the cited reference. Thus, this application is in condition for allowance. Accordingly, reconsideration and withdrawal of all rejections of the claims are respectfully requested.

Dated:



David L. Barnes, Esq.
Registration No. 47,407
Attorney/Agent for Applicant(s)
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square
Stamford, CT 06901-2682
Tel: (203) 327-4500
Fax: (203) 327-6401